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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Scott M. Frank

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

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3629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/750,001	<b>Applicant(s)</b> FRANK ET AL.	
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 86-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 86-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Request for Continued Examination*

1. The Request filed on 7/23/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/750001 is acceptable and a RCE has been established. An action on the RCE follows.

### *Response to Amendment*

2. Claims 1-85 and 104-109 have been cancelled; therefore Claims 86-103 are currently pending in application 09/750,001.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 86, 92, and 98 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**
5. Independent Claims 86, 92, and 98 disclose receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, wherein the

disclosure gift information includes information regarding disclosure gifts purchased by the organization from outside the organization and stocked by the organization for being given to the plurality of innovators for the organization; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, and automatically updating an associated balance of stocked disclosure gifts.

6. While the specification and original claims do support providing innovators with gifts for submissions, and determining the specific gift based on the innovation, neither the specification nor the original claims support tracking the inventory of the gifts, and or wherein the gifts are purchased from outside the organization.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 86-103 are rejected under 35 U.S.C. 103 as being unpatentable over Hunter (US 6,298,327) in view of Eggleston et al. (US 6,061,660).**

10. As per **independent Claims 86, 92, and 98**, Hunter discloses a computer-readable medium containing a program for use with a computer (apparatus, method) for tracking innovations as part of a system for managing protection and licensing of intellectual property assets (abstract, Fig.2, Fig.8), the program comprising: receiving intellectual property asset

protection data (inventive disclosure, C2-C5), wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets owned by the organization, wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception), wherein the intellectual property asset protection data further includes data related to a plurality of innovation disclosures, each innovation disclosure associated with one of a plurality of innovators for the organization (system tracks multiple inventions from multiple inventors); determining participation data for each of a plurality of innovator classes (C3 L53-67, invention categorized with specific technology group); and storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records (C2-C5, Fig.2, database).

11. While Hunter does disclose tracking innovations, inventors, and inventor related information (C11 L48-57, C18 Table 3), Hunter fails to expressly disclose receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, wherein the disclosure gift information includes information regarding disclosure gifts purchased by the organization from outside the organization and stocked by the organization for being given to the plurality of innovators for the organization; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, and automatically updating an associated balance of stocked disclosure gifts.

12. However, Eggleston discloses the creation of employee incentive programs, which include tracking/automated fulfillment of non-monetary reward distribution data to include sponsor and award databases (Fig.20, C8 L13-20, C31 L25-67, C32 L1-20, C45-C46). Furthermore, Eggleston discloses utilizing an awards tracking database and inventory replenishment technology (C39-40). *Finally, Eggleston discloses Merchandise as a prize type, which would have inherently been purchased from an outside source since Eggleston does not disclose using the system for a merchandise manufacturing company (Also – See 112 rejection above).*
13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, wherein the disclosure gift information includes information regarding disclosure gifts purchased by the organization from outside the organization and stocked by the organization for being given to the plurality of innovators for the organization; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, and automatically updating an associated balance of stocked disclosure gifts, as disclosed by Eggleston in the system disclosed by Hunter, for the advantage of providing a method for tracking innovations with the ability to increase effectiveness of the system by offering/tracking all facets of innovations submission process, to include compensating/awarding the innovation submitter. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

14. As per Claims 87, 93, and 99, Hunter discloses tracking and reporting costs associated with the purchase of disclosure gifts (C45-C46, sponsor and award database).
15. As per Claims 88, 94, and 100, Hunter discloses tracking and reporting information arranged by innovator regarding all disclosure gifts sent to each innovator of the plurality of innovators (C45 L27-50, consumer/participant database).
16. As per Claims 89, 95, and 101, Hunter discloses automatically totaling numbers of disclosure gifts distributed within a time period (C45-C46, sponsor and award database information/aggregation of information based on date).
17. As per Claims 90, 96, and 102, Hunter and Eggleston fail to expressly show wherein the plurality of innovator data, including employee/contractor status and a management /non-management status.
18. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator data stored. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a plurality of innovator data, to include: employee/contractor status and a management /non-management status, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

20. As per Claims 91, 97, and 103, while Hunter does disclose storing organization data associated with the innovator (Para0109, type of originator), Hunter fails to expressly show the organization data related to the innovator and including at least one of affiliate organization, company, division, and business unit.
21. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator descriptive data used. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a innovator descriptive data (organization al date) to include: at least one of affiliate organization, company, division, and business unit, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Response to Arguments***

23. Applicant's arguments filed 12/17/2007 regarding Claims 86-103 have been considered, but are not persuasive. The rejection will remain as NON-FINAL based on the sited prior art.
24. Regarding the Applicant's arguments, the Applicant is directed to the revised/clarified rejection above.



*Conclusion*

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

August 7, 2008  
/Jonathan Ouellette/  
Primary Examiner, Art Unit 3629